

Applicant : Isaac Ostrovsky et al.  
Appl. No. : 10/017,534  
Examiner : Patrick J. Connolly  
Docket No. : 701470.19

### Remarks

Claims 1-73 are currently pending, of which claims 1, 16, 22, 33, 53, 58, and 64 are independent. Claims 64-73 have been cancelled without prejudice.

#### Rejections under 35 USC §102

Claims 1, 3-5, and 58 are rejected under 35 USC §102, as being anticipated by Zeylikovich (U.S. Patent 5,943,133). Applicants respectfully disagree.

“[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference.” Celeritas Techs., Ltd. v. Rockwell Int’l. Corp., 150 F.3d 1354, 1361, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998). The standard for lack of novelty, that is, for “anticipation,” is one of strict identity. Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1296, 63 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2002). In the present Office Action, the Examiner’s rejection is based on the Zeylikovich reference, which fails to show all of the elements of the claimed invention.

As to claims 1 and 58, while the Zeylikovich reference may teach an apparatus having first and second beam splitters, the reference does not disclose having a “second sample light beam” and a “diffracted reference light beam . . . combined in the second beam splitter to form a combined light beam” as required by Claim 1. Nor does Zeylikovich disclose “combining [a] second sample light beam with [a] diffracted light beam by a beam splitter to form a combined light beam” as required by Claim 58.

As to claims 3-5, because claim 1 is patentably distinguishable over the Zeylikovich reference, then so are claims 3-5, which are dependent on claim 1.

#### Rejections under 35 USC §103

Claims 21, 22, 24, 25, 29, 30, 32, 35, 37, 38, 41, 43, 44, 47, 48, 60, 63, and 73 were rejected under 35 USC § 103 as being unpatentable over Zeylikovich (U.S. Patent 5,943,133). Applicants respectfully disagree.

Case law makes clear that obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

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suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *see also* MPEP § 2143.01. In the present Office Action, the Examiner's rejections are based on the Zeylikovich reference, the Zeylikovich reference in combination with Swanson (U.S. Patent No. 5,459,570), and the Zeylikovich reference in combination with Tearney (U.S. Patent No. 6,134,003); however, none of these references, in combination or separately, teach or suggest combining the elements of the instant invention.

Specifically, none of these references, in combination or separately, teach or suggest having "[a] second sample light beam and [a] diffracted reference light beam . . . combined in [a] second beam splitter" as required by claims 1, 22, and 33, having "[a] second beam splitter [form] two combined light beams" as required by claim 16, having "a second beam splitter for generating two combined light beams from [a] second sample light beam and [a] reference light beam" as required by 53, or "combining [a] second sample light beam with [a] diffracted light beam by a beam splitter to form a combined light beam" as required by claim 58.

Accordingly, independent claims 1, 16, 22, 33, 53 and 58 are patentable over the cited references, in combination or separately, as is the corresponding dependent claims.

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Conclusion

Prompt and favorable action on the merits of the claims is earnestly solicited. Should the Examiner have any questions or comments, the undersigned can be reached at (949) 567-6700.

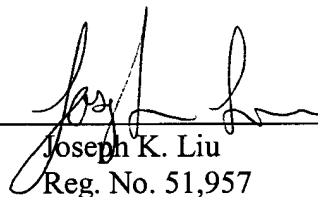
The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to Deposit Account No. 150665.

Respectfully submitted,

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Dated: September 18, 2003

By: \_\_\_\_\_

  
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